

Guy Ruttenberg, Bar No. 207937
guy@ruttenbergiplaw.com

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Bassil Madanat, Bar No. 285280
bassil@ruttenbergiplaw.com

RUTTENBERG IP LAW, A PROFESSIONAL CORPORATION
1801 Century Park East, Suite 1920
Los Angeles, CA 90067
Telephone: (310) 627-2270
Facsimile: (310) 627-2260
Attorneys for Plaintiff

**UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA**

j2 WEB SERVICES, INC.,
a Delaware Corporation,

CASE NO.: 15-cv-4877-BRO-FFM

**FINAL JUDGMENT OF
PERMANENT INJUNCTION**

Plaintiff,

v.

MITEL NETWORKS
CORPORATION,
a Canadian Corporation,

and

MITEL (DELAWARE), INC.
a Delaware Corporation

Defendants.

1 **FINAL JUDGMENT OF PERMANENT INJUNCTION**

2 Plaintiff j2 Web Services, Inc. j2 filed a Complaint against Mitel Networks
3 Corporation and Mitel (Delaware), Inc. (collectively, “Mitel”) on June 26, 2015,
4 seeking a permanent injunction and other relief.

5 Mitel consents to entry of this Final Judgment of Permanent Injunction.

6 Now, therefore, it is accordingly ORDERED, ADJUDGED and DECREED as
7 follows:

8 **Jurisdiction and Venue**

9 1. This Court has subject matter jurisdiction over this action pursuant to 28
10 U.S.C. §§ 1331, 1338 and 1367.

11 2. This Court has personal jurisdiction over Mitel.

12 3. Venue is proper in this District.

13 **Stipulated Facts**

14 4. j2 is the owner of the following registered United States trademarks:

- 15 • United States Trademark Registration No. 2,836,857 (the “857
16 Registration”) for the standard character mark ONEBOX in connection
17 with the following: Telecommunications services, namely, the
18 transmission of voice, data, images, video and messages over the
19 Internet;
- 20 • United States Trademark Registration No. 4,048,389 (the “389
21 Registration”) for the standard character mark ONEBOX in connection
22 with the following: Computer software for use in sending and receiving
23 facsimiles, accessing voice mail, and managing and coordinating
24 messages in the field of messaging; computer software for use in data,
25 voice and email communications, namely, software for use in
26 transmitting data, voice and email via computer and
27 telecommunications networks; computer software for use in integration,
28 transmission, retrieval and storage of documents, messages, audio text

and/or images; computer software used for email, voice communication, web and Internet security; data, document and email storage and archiving software; and communications software for use in document conversion in the field of messaging; and

- United States Trademark Registration No. 4,048,390 (the “’390 Registration”) for the standard character mark ONEBOX UNIFIED MESSAGING in connection with the following: Telecommunication services, namely personal communication services; electronic transmission of messages and data transmission of sound, video and information; data transmission and reception service via telecommunication means; electronic exchange of voice, data, and graphics accessible via computer and telecommunication networks; instant messaging services; voice over ip (VOIP) services; video and audio conferencing services conducted via the web, telephone, and mobile devices; communications by computer terminals; and telephone communications services;

5. The ’857, ’389 and ’390 Registrations are valid and subsisting.

6. ONEBOX® and ONEBOX UNIFIED MESSAGING® identify j2 as the source of the goods and services recited in ’857, ’389 and ’390 Registrations and are not generic.

7. j2 and/or its predecessors-in-interest have marketed unified messaging and communications services under the ONEBOX® mark since at least the late 1990s.

8. j2 and/or its predecessors-in-interest have marketed computer software, including unified messaging and communications services software under the ONEBOX® mark since at least 2009.

9. j2 and/or its predecessors-in-interest have marketed unified messaging and communications services under the ONEBOX UNIFIED MESSAGING® mark since at least 2002.

1 10. j2 and/or its predecessors-in-interest have marketed unified messaging and
2 communications services through the www.onebox.com website since the late 1990s.

3 Terms of Permanent Injunction

4 11. Mitel and each of its officers, directors, stockholders, owners, agents,
5 representatives, employees, affiliates, related entities, and all those acting in concert or
6 privity with it who receive actual notice of this Order by personal service or otherwise,
7 as well as any successors-in-interest (collectively, "Mitel Parties"), are RESTRAINED
8 and ENJOINED in the United States from using j2's ONEBOX® and/or ONEBOX
9 UNIFIED MESSAGING® marks, in any form or stylization, or any other similar mark
10 that is likely to cause confusion, deception or mistake as to source, sponsorship or
11 affiliation with j2.

12 12. The Mitel Parties are RESTRAINED and ENJOINED from using or
13 creating any false designation of origin or false impression of association, including
14 using j2's ONEBOX® and/or ONEBOX UNIFIED MESSAGING® marks, or any
15 similar mark, name or source indicia, in connection with unified messaging, unified
16 communications or telecommunications products or services, and any other goods or
17 services, that can, or are likely to, lead the public to believe that such goods or services
18 are in any manner associated or connected with j2, or are licensed, approved, authorized
19 or authenticated in any way by j2.

20 13. The Mitel Parties are RESTRAINED and ENJOINED from making, using,
21 offering to sell, importing, or distributing any unified messaging, unified
22 communications or telecommunications products or services under the names
23 "OneBox" or "OneBox Unified Messaging" (or under similar names) in the United
24 States or in a manner that substantially affects commerce in the United States.

25 14. The Mitel Parties are RESTRAINED and ENJOINED from marketing,
26 selling, advertising, or promoting any product or service using the ONEBOX® and/or
27 ONEBOX UNIFIED MESSAGING® marks in the United States or in a manner that
28 substantially affects commerce in the United States.

1 15. The Mitel Parties are RESTRAINED and ENJOINED from using the
2 ONEBOX® and/or ONEBOX UNIFIED MESSAGING® marks within website source
3 code in the United States or in a manner that substantially affects commerce in the
4 United States.

5 16. The Mitel Parties are RESTRAINED and ENJOINED from use or display
6 on any webpage (including as the title of any web page) or any advertising links to
7 other websites, from search engines' databases or cache memory, and in any other form
8 of use of such terms that is visible to a computer user or serves to direct computer
9 searches to websites registered, owned, or operated by Mitel, including the Internet
10 websites operating under the domain names used and controlled by Mitel, such that the
11 use is visible to consumers in the United States.

12 17. The Mitel Parties are RESTRAINED and ENJOINED from offering a
13 ONEBOX® or ONEBOX UNIFIED MESSAGING® mobile application anywhere in
14 the United States or in a manner that substantially affects commerce in the United
15 States.

16 18. The Mitel Parties shall remove and discontinue all mobile applications that
17 use the name “OneBox” or any similar mark in the United States or in a manner that
18 substantially affects commerce in the United States. The Mitel Parties shall remove and
19 discontinue such mobile applications on any and all platforms, including without
20 limitation on the iPhone, Android and Blackberry platforms in the United States or in a
21 manner that substantially affects commerce in the United States. Without limitation,
22 the Mitel Parties shall remove and discontinue all such mobile applications marketed as
23 the “Mitel OneBox” or “Aastra OneBox.” Once these have been removed and/or
24 discontinued, the Mitel Parties shall not resume the mobile applications.

25 19. The Mitel Parties shall remove and discontinue any and all websites that
26 use “onebox” in the uniform resource locator (“URL”) and/or uniform resource
27 identifier (“URI”) in the United States or in a manner that substantially affects
28 commerce in the United States. Without limitation, the Mitel Parties shall remove and

1 discontinue the www.mitel.com/onebox and www.aastra.com/onebox web pages and/or
2 make sure that such pages are not available in the United States or in a manner that
3 substantially affects commerce in the United States. Once removed, the Mitel Parties
4 shall not resume use of these web pages in conjunction with unified messaging, unified
5 communications or telecommunications products or services in the United States or in a
6 manner that substantially affects commerce in the United States.

7 20. The Mitel Parties shall discontinue the use of any and all brochures,
8 advertising, websites and/or any other sales or marketing materials or using the names
9 “OneBox” and/or “OneBox Unified Messaging” (or similar marks) in conjunction with
10 unified messaging, unified communications or telecommunications products or services
11 in the United States or in a manner that substantially affects commerce in the United
12 States.

13 21. The Mitel Parties shall remove any U.S. contact information from any and
14 all brochures, advertising, websites and/or any other sales or marketing materials using
15 the names “OneBox” and/or “OneBox Unified Messaging” (or similar marks) in
16 conjunction with unified messaging, unified communications or telecommunications
17 products or services.

18 22. The Mitel Parties shall not conduct any sales or marketing for unified
19 messaging, unified communications or telecommunications products or services under
20 the “OneBox” and/or “OneBox Unified Messaging” names (or similar marks) in the
21 United States or in a manner that substantially affects commerce in the United States.

22 23. The Mitel Parties shall not register or bid on the ONEBOX® or ONEBOX
23 UNIFIED MESSAGING® trademarks, whether individually or together with other
24 trademarked or non-trademarked terms of j2, as a trademark or key word on any
25 Internet or other search engine. The Mitel Parties shall also not instruct, cooperate with
26 or otherwise cause a third party to do any of the foregoing.

27 24. Mitel shall circulate a Memorandum to all of its United States distributors
28 and sales personnel, in substantially the form set forth in Exhibit A, notifying the

1 distributors and personnel that Mitel does not offer any products or services under the
2 “OneBox” or “OneBox Unified Messaging” (or similar) names.

3 25. Within two business days of the Court’s entry of this Order, Mitel shall
4 provide j2 with a statement verifying under oath, based upon personal knowledge or
5 information and belief, the volume of historical sales in the United States of Mitel
6 products and services sold under the “OneBox” (or similar) brand, and any revenue
7 derived therefrom. If Mitel’s total historical sales in the United States of Mitel products
8 and services sold under the “OneBox” (or similar) brand has been less than \$10,000, a
9 sworn statement under oath to that effect would satisfy Mitel’s obligation under this
10 paragraph.

11 26. The Mitel Parties shall use commercially reasonable efforts to ensure that
12 their distributors, as well as any officers, directors, stockholders, owners, agents,
13 representatives, employees, affiliates, related entities, and all those acting in concert or
14 privity, and successors of any of the foregoing, receive actual notice of this Order and
15 otherwise assist in compliance with the terms of this Order.

16 Damages, Costs and Attorneys Fees

17 27. The Court does not award any damages.

18 28. Each party shall bear its own costs and attorneys’ fees.

19 * * *

20 There being no just reason for delay, the Clerk is directed to enter this Final
21 Judgment forthwith.

22
23 IT IS SO ORDERED.

24
25 DATED: July 24, 2015

26 By: 

27 United States District Court Judge
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